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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,568	06/25/2003	Daniel S. Choi	WEB-922-CIP-US	3360

7590

09/05/2006

Baker & McKenzie LLP
130 E. Randolph Drive
Chicago, IL 60601

EXAMINER

CHOI, JACOB Y

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,568

Applicant(s)

CHOI ET AL.

Examiner

Jacob Y. Choi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 31-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-30 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/25/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 31-44 in the reply filed on June 22, 2006 is acknowledged.

Drawings

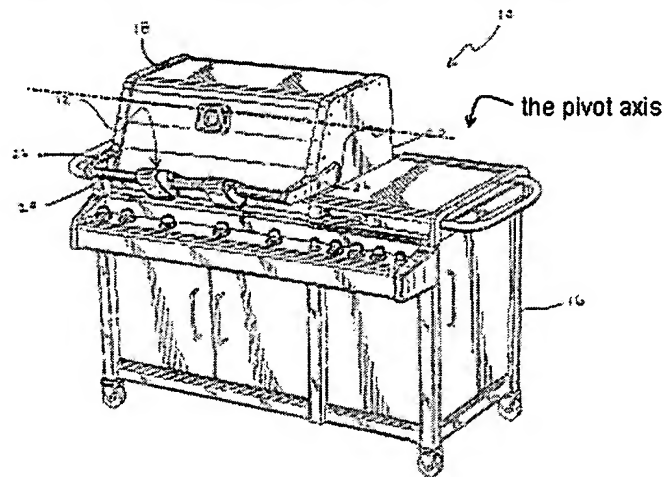
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the handle being attached to the upper member and being generally parallel to the horizontal axis must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note: Figure 3 and page 10; lines 10-15 describes the arrow being "... open position ... closed position ... etc."). For example, "*the pivot axis*" would be a line of axis that passes the hinge from one end of the upper/lower member to the other end.



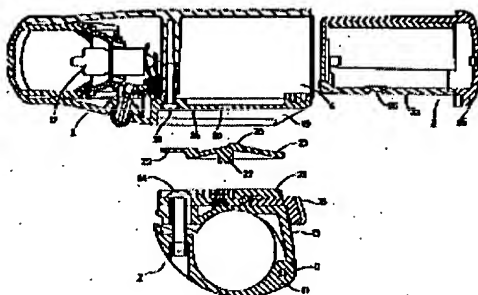
Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

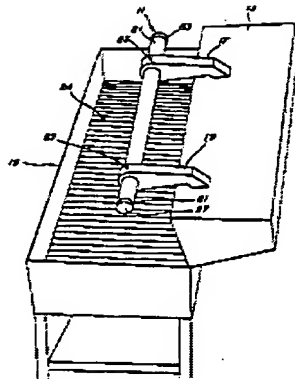
4. Claims 1, 6, 7, 8, 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055).

Regarding claims 1, 6, 7 and 8, Shoji disclose a fixture (1) having a first mating member (11), the fixture being fabricated to be secured to the handle (e.g., column 3, line 9), a removable first pod (1) having an illumination device (17) and a second mating member (13), the second mating member of the first pod removably engaging the first mating member of the fixture to removably secure the first pod to the fixture.



Shoji discloses the claimed invention, except for the housing has a first connector to specifically secure the housing to a barbecue grill. However, reference Shoji suggests that the illumination device may be removably attached to the handle or the like (e.g., column 3, line 9).

Grisamore et al. teaches a barbecue light (having an upper member and a lower member defining a cooking chamber, the cooking chamber having a cooking grid, the upper member covering the lower member in a closed position ... etc) where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of need to illuminate cooking surface of the barbecue grill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of Shoji onto the barbecue grill lid handle of Grisamore et al. to illuminate the cooking area.



Note: Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972).

Regarding claim 10, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. In addition, Shoji discloses the first mating member depending from the fixture is one of a male protrusion or a female receiver, and wherein the second mating member depending from the pod is the other of the male protrusion or female receiver.

Regarding claim 11, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. In addition, Shoji discloses the male protrusion and the female receiver mate in a frictional fit to secure the pod to the fixture.

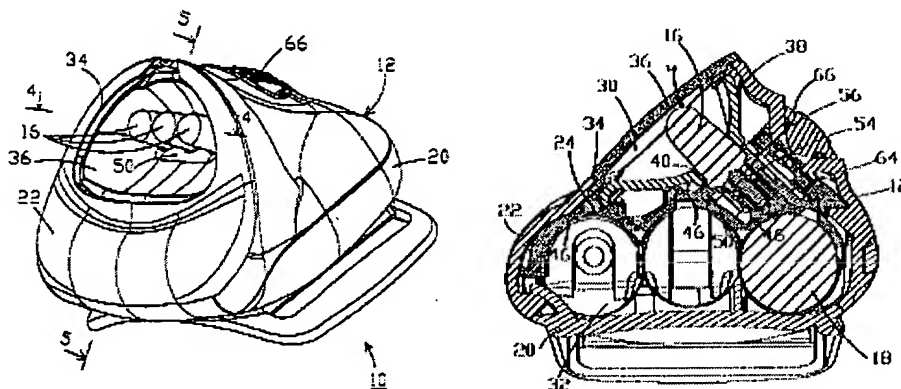
Regarding claim 12, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. In addition, Shoji discloses one of the male protrusions and the female receiver has a stop to position the pod on the fixture.

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7. Claims **2, 9, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055) as applied to claim 1 above, and further in view of Petzl et al. (USPN 6,499,859).

Regarding claims 2, 9, and 13, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. Shoji lacks specific teachings of a manual switch, however drawing Figures 1 of Shoji clearly shows a manual switch electrically connected to the internal power source to control illumination of the device.

Also, Petzl et al. teaches the common manual switch that is utilized for a portable lighting lamp.

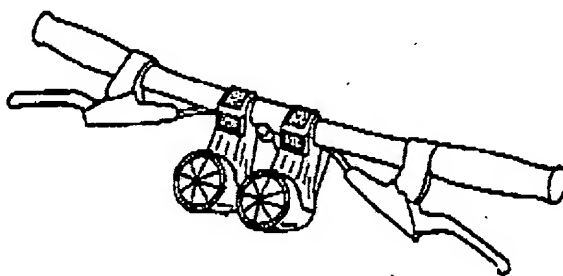


It would have been obvious to one of ordinary skill in the art at the time of the invention to modify teachings of Shoji with Petzl et al. to include a switch member to operate the lighting means under user's control.

5. Claims **3-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055) as applied to claim 1 above, and further in view of Sutherland et al. (USPN 5,641,220).

Regarding claim 3, Shoji in view of Grisamore et al. discloses the claimed invention, except for an additional or second lighting device that is in connection with the first lighting device as described above.

Sutherland et al. teaches multiple or two lighting device that is in connection with the first light device (Figure 11).



It would have been obvious to one of ordinary skill in the art at the time of the invention to provide additional or second housing member in connection with the first lighting device as taught by Southerland et al. to provide even great illumination in varying positions. In addition, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 4, Shoji in view of Grisamore et al. and Sutherland et al. discloses the claimed invention, explained above. In addition, Sutherland et al. discloses the first pod has a first internal power source and a first switch to independently manipulate illumination of the illumination device of the first pod, and wherein the second pod has a second internal power source and a second switch to independently manipulate illumination of the illumination device of the second pod.

Regarding claim 5, Shoji in view of Grisamore et al. and Sutherland et al. discloses the claimed invention, explained above. In addition, Sutherland et al. discloses the fixture has a handle portion (handle bar) between the first pod and the second pod.

6. Claims **15-18, 21, 22-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055) and Petzl et al. (USPN 6,499,859).

Regarding claims 15, 23, 24 & 26, Shoji discloses a housing (Figure 1) having a connector (e.g., 11, 13) to secure the housing to the handle and having a first mating member (11), a removable first pod (1) having an illumination device and a second mating member (13), the second mating member of the first pod removably connecting the first mating member of the housing to removably secure the first pod to the housing, the first pod having an independent internal power source (3) located within the first pod for illuminating the illumination device of the first pod (1).

Shoji lacks specific teachings of the housing being attached to the barbecue grill & details of a manual switch. However, reference Shoji suggests that the illumination device may be removably attached to the handle or the like (column 3, line 9) & drawing Figures 1 of Shoji clearly shows a manual switch electrically connected to the internal power source to control illumination of the device.

Grisamore et al. teaches a barbecue light where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of

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need to illuminate cooking surface of the barbecue grill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of Shoji onto the barbeque grill lid handle of Grisamore et al. to illuminate the cooking area.

Petzl et al. teaches the common manual switch that is utilized for a portable lighting lamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify teachings of Shoji with Petzl et al. to include a switch member to operate the lighting means under user's control.

Note: It has been held that the recitation that an element is "*adapted to*" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 16, Shoji in view of Grisamore et al. & Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses the second mating member of the first pod slidingly engages (14) the first mating member of the housing to removably connect the first pod to the housing.

Regarding claims 17 & 21, Shoji in view of Grisamore et al. & Petzl et al. discloses the claimed invention, explained above. In addition, Petzl et al. discloses the illumination device comprises a plurality of light emitting diodes (16).

Regarding claim 18, Shoji in view of Grisamore et al. & Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses the light bulb of the illumination device utilizes reflector and lens member to directionally focus in varying positions.

Regarding claim 22, Shoji in view of Grisamore et al. & Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses the first mating member removably engages the second mating member without hardware.

Regarding claim 25, Shoji in view of Grisamore et al. & Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses an extension depends from the housing, and wherein the extension has a first connector the secure the extension to a surface.

7. Claims **19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055) and Petzl et al. (USPN 6,499,859) as applied to claim 15 above, and further in view of Sutherland et al. (USPN 5,641,220).

Regarding claim 19, Shoji in view of Grisamore et al. & Petzl et al. discloses the claimed invention, except for an additional or second lighting device that is in connection with the first lighting device as described above.

Sutherland et al. teaches multiple or two lighting device that is in connection with the first light device (Figure 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide additional or second housing member in connection with the first to provide even great illumination in varying positions. In addition, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

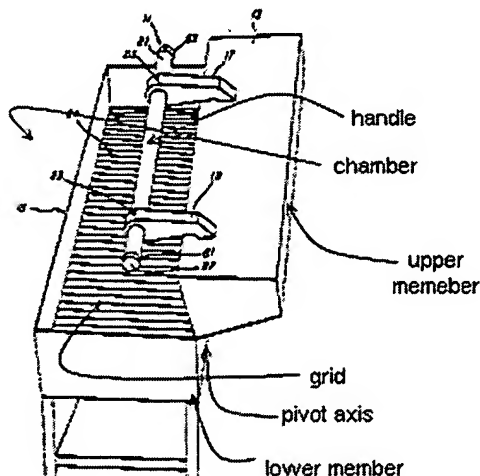
Regarding claim 20, Shoji in view of Grisamore et al. & Petzl et al. and in further in view of Sutherland et al. disclose the claimed invention, explained above. In addition, Shoji discloses housing has a handle portion (column 3, line 9) for grasping by the user, the handle portion located between the first pod and the second pod when first and second pods are removably secured to the housing.

8. Claims **27-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055) and Petzl et al. (USPN 6,499,859) and further in view of Sutherland et al. (USPN 5,641,220).

Regarding claims 27 & 30, Shoji discloses a housing (Figure 1) having a first mating member (11), a removable first pod (1) having an illumination device and a second mating member (13), the second mating member of the first pod removably connecting the first mating member of the housing to removably secure the first pod to the housing, the first pod having an independent internal power source (3) located within the first pod for illuminating the illumination device of the first pod (1).

Shoji lacks teachings of the housing being attached to the barbecue grill, details of a manual switch & an additional or second lighting device that is in connection with the first lighting device as described above. Shoji suggests that the illumination device may be removably attached to the handle or the like (column 3, line 9) & drawing Figures 1 of Shoji clearly shows a manual switch electrically connected to the internal power source to control illumination of the device.

Grisamore et al. discloses (*admitted applicant's prior art*) a barbecue light having an upper member and a lower member defining a cooking chamber, the cooking chamber having a cooking grid, the upper member covering the lower member in a closed position, where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill.



Grisamore et al. teaches a barbecue light where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of need to illuminate cooking surface of the barbecue grill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of Shoji onto the barbecue grill lid handle of Grisamore et al. to illuminate the cooking area.

Petzl et al. teaches the common manual switch that is utilized for a portable lighting lamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify teachings of Shoji with Petzl et al. to include a switch member to operate the lighting means under user's control.

Sutherland et al. teaches multiple or two lighting device that is in connection with the first light device (Figure 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide additional or second housing member in connection with the first to provide even great illumination in varying positions. In addition, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 28, Shoji in view of Grisamore et al. & Petzl et al. and further in view of Sutherland et al. discloses the claimed invention, explained above. In addition, Sutherland discloses the second mating members of the first and second pods slidingly engage the respective first mating members of the housing to independently removably connect the first and second pods to the housing.

Regarding claim 29, Shoji in view of Grisamore et al. & Petzl et al. and further in view of Sutherland et al. discloses the claimed invention, explained above. In addition, Petzl et al. discloses the illumination devices of the first and second pods comprises a plurality of light emitting diodes.

Allowable Subject Matter

9. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed June 22, 2006 have been fully considered but they are not persuasive. The applicant's representative essentially restates arguments from the previously filed response(s). The examiner firmly stands behind his reasons for the prior art rejection(s), which are clearly stated in above paragraphs 4-8.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In this case, Grisamore et al. suggest necessary need to illuminate the cooking area onto the barbeque grill lid handle and reference Shoji suggests that the illumination device may be removably attached to the handle or the like (column 3, line 9). See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that reference Shoji is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned (e.g., to illuminate an area (e.g., cooking area)), in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977

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F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, (e.g., the mentioned references, Shoji & Grisamore, are classified under “class 362” – general illumination).

The recitation for example, “... *in a barbecue grill having an upper member and a lower member defining a cooking chamber, the cooking chamber having a cooking grid, the upper member covering the lower member in a closed position*” is now given patentable weight based on Jepson type format (e.g., “*improvement comprising*”), although the recitation occurs in the preamble. However, the following limitation is now considered as applicant's admitted prior art, meaning the examiner has treated such subject matter as the work of another.

Note: Drafting a claim in Jepson format (i.e., the format described in 37 CFR 1.75(e); see MPEP § 608.01(m)) is taken as an implied admission that the subject matter of the preamble is the prior art work of another. *In re Fout*, 675 F.2d 297, 301, 213 USPQ 532, 534 (CCPA 1982) (holding preamble of Jepson-type claim to be admitted prior art where applicant's specification credited another as the inventor of the subject matter of the preamble). A statement by an applicant during prosecution identifying the work of another as “prior art” is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). Consequently, the examiner must determine whether the subject matter identified as “prior art” is applicant's own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another.

Regardless, the limitations in preamble is taught by the cited prior art Grisamore, disclosing every features of well know barbecue grill with an upper member and a lower member defining a cooking chamber. The rejection(s) stand under 35 U.S.C. 103(a) as being unpatentable over **Shoji** (USPN 5,378,553) in view of **Grisamore et al.** (USPN 6,132,055), where there is a clear motivation that has been taught by the prior art reference **Grisamore**, necessary need to illuminate the cooking area onto the barbeque

grill lid, in combination with teachings of **Shoji**, the illumination device having a removably attached to the handle or the like.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*the grill handle rotates about an axis which is generally parallel to the longitudinal axis of the handle and the rotational axis of a barbecue grill lid is significantly offset from the handle ... barbecue grill handles rotate about their longitudinal axis when opening and closing the barbecue grill, due to the offset rotational axis ... etc.*") are not recited in the rejected claim(s) (e.g., especially in claims **1, 15 & 31**). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Again, in this case, reference **Shoji** suggests that the illumination device may be removably attached to the handle or the like (e.g., column 3, line 9). **Grisamore et al.** teaches a barbecue light where the handle (e.g., 21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of need to illuminate cooking surface of the barbecue grill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of **Shoji** onto the barbecue grill lid handle of **Grisamore et al.** to illuminate the cooking area.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Response to Amendment

11. Examiner acknowledges that the applicant has amended claims 1, 15, 26 and
27. Currently, claims 1-30 are pending in the application.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacob Y Choi
Examiner
Art Unit 2875

JC



Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800